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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,320	10/17/2001	Michael J. Russell	9721.9544B	6571

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EXAMINER

RUDDY, DAVID M

ART UNIT

PAPER NUMBER

3739

DATE MAILED: 02/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/982,320

Applicant(s)

RUSSELL, MICHAEL J. 

Examiner

David M Ruddy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 October 2001.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

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**DETAILED ACTION*****Claim Rejections - 35 USC § 101***

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-29 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-29 of copending Application No. 09/903778. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8, 10-12, 20, 24, 25, and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Billin (patent #3,761,769). Billin discloses a medical electrode for preventing harmful current from passing to a patient.(as explained in column 1, lines 5-10). As set forth in column 1, lines 30-35, Billin discloses the old and well known use of

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a fuse in electrical circuits to prevent a damaging overload of current throughout the circuit. As seen in figures 1-2 the switch system "S" provides a circuit breaker means for preventing the flow path of current of a dangerous level. As seen in figure 1, the current is generated from a power source (item "AC").

Claims 1-5, 9, 13, 24, 25, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Miller (patent #3,986,495). Miller discloses a medical electrode for preventing the passage of harmful current to a patient, the system comprising (as seen in figure 1) a diode current limiter (item 11) which limits many types of excessive current to protect the patient from harmful charges (see the discussion of figure 4).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14-18, 20, 26, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Billin. With reference to the rejections above Billin discloses all that is claimed except an expressed recitation of the electrode types recited in claims 14-18, an expressly disclosed separable arrangement of claim 20, the specific species (noting that the genus is in fact disclosed by Billin) of fuse recited in claims 26-27.

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Applicant recites a laundry list of possible electrode types for which the current limiter of the present invention can be used. The structure of the electrode type does not appear to be the novel or inventive aspect of the current application as it appears from the current specification. Applicant has set forth no criticality as to why a choice of the specific electrode type (as they appear in claims 14-18) is necessary, solves any stated problem, or is for any particular purpose, and it appears that the invention would work equally well regardless of the type of electrode used with the patient protection device. Accordingly, the choice of what electrode type to use for the protection of patient harm is seen to be an obvious matter of engineering design.

The examiner further takes official notice of the electrode types recited in claims 14-18 and submits that their use is old and well known in the art of electrode design. Accordingly their use would have been obvious to one having ordinary skill in the art.

Applicant recites two specific types of fuses in claims 26-27 with which the current limiter of the present invention can be used. The specific type of fuse appears to be merely preferred embodiments and does not appear to be the novel or inventive aspect of the current application as it appears from the current specification. Applicant has set forth no criticality as to why a choice of the specific fuse type (as they appear in claims 26-27) is necessary, solves any stated problem, or is for any particular purpose, and it appears that the invention would work equally well in the embodiment disclosed by Billin. Accordingly, the choice of what fuse type to use for the protection of patient harm is seen to be an obvious matter of engineering design.

***Allowabl Subject Matter***

Claims 19, and 21-23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art does not teach the limitations of a contact lens electrode in combination with the limitations of the recited current stoppage means recited in the preceding claims.

The prior art does not teach the use of recitation of the spatial relationship between the recited first and second member with respect to the patient contacting surface in combination with the limitations of the recited current stoppage means recited in the preceding claims.

***Conclusion***

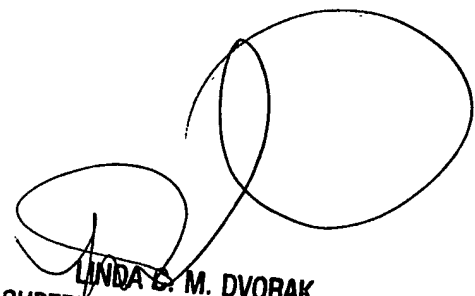
Any inquiry concerning this communication or earlier communications from the examiner should be directed to David M Ruddy whose telephone number is (703) 308-3595. The examiner can normally be reached on Mon-Fri 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (703) 308-0994. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-3376 for regular communications and (703) 746-3376 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

DR  
January 23, 2003



LINDA S. M. DVORAK  
SUPERVISORY PATENT EXAMINER  
GROUP 3700